

**REMARKS**

This communication is responsive to the Office Action dated October 9, 2007 and received in this application. Claims 15-23 remain pending for consideration. Applicant respectfully requests reconsideration and allowance of the pending claims.

Claims 15-23 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,779,021 to Bates et al. ("Bates"). This rejection is traversed.

Claim 15 recites: *[a] method for restoring electronic mail messages to a mail server, the method comprising:*

*determining that an electronic mail message addressed to a particular user is resident at a mail server;*

*receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server;*

*receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure; and*

*restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request.*

Applicant's claimed invention offers the ability to restore e-mails on a mail server after the e-mail has been downloaded to a mail client and deleted from the mail server.

These claimed features are neither disclosed nor suggested by Bates, which discloses a spam filtering technique that simply displays potentially undesirable e-mail in a distinct manner for the user (e.g., in a different folder). In operation, a user may indicate that an e-mail flagged as spam is not actually spam. However, this merely changes the designation of such an e-mail, and there is

no mention whatsoever in Bates that the e-mail is (or was) deleted from the mail server, or of restoring a deleted e-mail on the mail server.

Accordingly, various features recited in claim 15 are absent from Bates. For example, there is no disclosure or suggestion of “*receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server,*” as claimed by Applicant. The Action cites column 6, lines 26-54 for alleged disclosure of these features, but this is clearly erroneous. In fact, the cited passage merely states that predicted spam is displayed in some distinct fashion, such as color shading, lower order listing, or display in a distinct category. There is no mention, either in the cited passage or anywhere else in the document, of the type of e-mail processing that entails downloading the message to the client and deleting the electronic message from the mail server as claimed. Accordingly, Bates fails to disclose “*receiving the electronic mail message at a mail client from the mail server pursuant to an electronic mail downloading procedure that entails deleting the electronic mail message from the mail server,*” as claimed by Applicant.

Bates does mention that a user may confirm a designated message as SPAM. However, this is not what is claimed – there remains, in this example, no disclosure in Bates of restoring any e-mail that has already been deleted, spam or otherwise. Accordingly, Bates also clearly fails to disclose or in any way suggest “receiving a request to restore the electronic mail message on the mail server following a completion of the electronic mail downloading procedure [which entails deleting the electronic mail message from the mail server, as claimed]” and “restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server in response to receiving the request.”

With regard to these features, the Action states that in Bates “spam e-mails downloaded to client are deleted and moved to trash folders, if client determines that e-mails are not SPAM, emails are restored”. (Office Action, at p. 2). However, Bates offers no such disclosure, and even presuming what is stated is true, this is not what is actually claimed. The reference to trash folders in Bates is the client-side trash folders into which SPAM e-mails are placed by user indication, on

the client-side. There is no mention of an e-mail downloading procedure that entails deleting the electronic mail message from the mail server, which would have occurred prior to the user's review of the e-mail.

Moreover, there is never any mention of restoring the electronic mail message as though the electronic mail message had not been downloaded from the mail server. Moving the e-mail from the SPAM folder to another folder at a client device is not an example of this. In such a situation, the effected e-mail remains resident at the mail server throughout the process (there is never any mention that it was deleted) and the user's activity merely updates the location of the message into the desired folder. There is no discussion in Bates about restoring an e-mail already deleted from the mail server.

Bates is simply not the type of e-mail processing wherein the messages are routinely deleted from the mail server pursuant to downloading them to the client device, hence there is never any discussion of such a procedure in Bates, and Bates never seeks to even address the potential issue wherein a user may wish to restore an e-mail to the mail server. Rather, Bates simply deals with allocating SPAM to appropriate distinctive areas, and allowing a user to manage SPAM from among received e-mails. This is a different problem with wholly different processes as compared to those claimed by Applicant, and as such Bates is completely silent as to deleting e-mails and restoring deleted e-mails at the mail server.

Because Bates fails to disclose, teach or suggest various features of claim 15, a *prima facie* anticipation rejection has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). *See also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

For reasons similar to those provided regarding claim 15, Bates also fails to disclose or suggest independent claim 18. The dependent claims are distinct for their incorporation of these claimed features as well as for their separately recited patentably distinct features.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 15-23 under 35 U.S.C. § 102(b) as being anticipated by Bates.

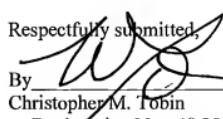
In view of the foregoing arguments, all claims are believed to be in condition for allowance. If any further issues remain, the Examiner is invited to telephone the undersigned to resolve them.

This response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If any fees are due during the prosecution of this application, at any time, please charge our Deposit Account No. 18-0013, from which the undersigned is authorized to draw, under Order No. AST-0001.

Dated: *Oct. 13, 2009*

Respectfully submitted,

By 

Christopher M. Tobin

Registration No.: 40,290  
RADER, FISHMAN & GRAUER PLLC  
Correspondence Customer Number: 23353  
Attorney for Applicant